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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,699	03/10/2000	Robert Mitchell Crowl	4-31336P1	,5894

7590

06/26/2002

Thomas Hoxie
Novatis Corporation
Patent and Trademark Dept
564 Morris Avenue
Summit, NJ 07901-1027

EXAMINER

NOLAN, PATRICK J

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 06/26/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/522,699

Applicant(s)
Crowl et al.

Examiner
Patrick J. Nolan

Art Unit
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 3, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 9-11, and 20-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 7, 10, 11, 20, and 21 is/are allowed.
- 6) ☒ Claim(s) 3, 4, 9, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Part III DETAILED ACTION

1. Claims 1-4, 7, 9-11, 20-22 are pending.
2. It is noted that Applicant's after-final submitted on 6-3-02 has been entered. New grounds of rejections are set forth below.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3, 4, 9 and 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a fragment of SEQ ID NO. 1 that hybridizes to SEQ ID NO. 1 and is used as a probe or a fragment of SEQ ID NO. 1 that encodes a peptide that is used to make antibodies that specifically bind to SEQ ID NO. 1, does not reasonably provide enablement for the use of any fragment of SEQ ID NO. 1 or a vector comprising said DNA fragment. The specification does not enable any person skilled in the art to which it pertains, or with which it is most clearly connected, to use the invention commensurate in scope with these claims.

The specification provides no guidance as to what else one of skill in the art would use a fragment of SEQ ID No. 1 for besides as a probe or a encoding a peptide for antibody generation. One of skill in the art would not know what to use a single nucleic acid fragment of SEQ ID NO. 1 for, or a vector with only one coding sequence. Since the state of the art would not be able to use single nucleic acid fragments in a vector or as a DNA fragment, it would be unpredictable to practice the full scope of Applicant's claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Serial Number: 09/522,699
Art Unit: 1644

3

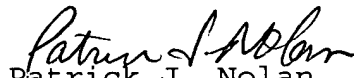
Claim 22 is rejected under 35 U.S.C. § 102(b) as being anticipated by Vollhardt et al. (U).

Vollhardt et al., specifically teaches a single polynucleotide of DNA, which reads upon a fragment of Applicant's claimed SEQ ID NO. 1 (page 1261, in particular).

The prior art teachings anticipate the claimed invention.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Tuesday through Friday from 8:00 am to 5:30 pm.

5. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7401. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.


Patrick J. Nolan, Ph.D.
Primary Examiner, Group 1640
June 25, 2002